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PATENT APPLICATION

ATTORNEY DOCKET NO. 200206923-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Sesek, et al.

Confirmation No.: 5874

Application No.: 10/762,853

Examiner: Jamila O. Williams

Filing Date: January 22, 2004

Group Art Unit: 3722

Title: ADVENTURE PHOTOGRAPHY METHOD AND APPARATUS

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Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on September 4, 2007.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$520.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

- ☒ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☒ 1st Month
\$120☐ 2nd Month
\$460☐ 3rd Month
\$1050☐ 4th Month
\$1640

- ☐ The extension fee has already been filed in this application.

- ☐ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 640. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

- ☐ A duplicate copy of this transmittal letter is enclosed.

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Respectfully submitted,

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02 FC:1251510.00 DA
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DEC 04 2007

First Named Inventor	Robert Sesek, et al.	APPEAL BRIEF
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I. Introduction

Appellant filed a Notice of Appeal to the Board of Patent Appeals and Interferences on September 4, 2007. One copy of this Appeal Brief is hereby filed, in accordance with 37 C.F.R. § 41.37(a)(1), and is accompanied with a authorization to charge Deposit Account No. 08-2025 in the amount of \$500.00 for the fee as required under 37 C.F.R. § 41.20(b)(2).

II. Real Party in Interest

The present application has been assigned to Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business at 20555 SH 249, Houston, TX 77070 (hereinafter "HPDC"), in an assignment recorded on January 22, 2004, at Reel 014931, Frame 0469. HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

III. Related Appeals and Interferences

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present Appeal.

IV. Status of Claims

Claims 1-13, 20-21 and 23-24 are pending in the application. Claims 14-19 and 22 were previously canceled. Claims 1-13, 20-21 and 23-24 are the subject of this Appeal. The remaining dependent claims are not separately argued under the provisions of 37 CFR 41.37(c)(1)(vii).

In the Final Office Action mailed May 2, 2007, claims 20-22 were rejected under 35 U.S.C. §112, second paragraph. Claims 1-9 and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruebens (U.S. Patent No. 4,965,948). Claims 10-13 and 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sussman et al. (U.S. Patent No. D468,350 S) or Smith (U.S. Patent No. 6,257,621 B1) in view of Ruebens (U.S. Patent No. 4,965,948). The Advisory Action mailed July 30, 2007, maintained the rejections of the Final Office Action.

See Appendix A for claims 1-13, 20-21 and 23-24 involved in this Appeal.

V. Status of Amendments

All amendments to the claims have been entered.

VI. Summary of Claimed Subject Matter

Claim 1 is directed to a photography guidebook 104 or 200 (Figs 1, 2; page 4, paragraph 0021, lines 1-3), comprising a plurality of blank photograph locations 202 (Fig. 2; page 4, paragraph 0021, lines 2-4) and a plurality of pre-printed photograph descriptions 204 (Fig. 4; page 4, paragraph 0021, lines 3-5) of the blank photograph locations.

Claim 7 is directed to an adventure workbook 104 (Fig. 1; page 3, paragraph 0019, lines 1-2), comprising a plurality of blank photograph locations (page 4, paragraph 0019, lines 2-6; Fig. 2; page 4, paragraph 0021, lines 2-4) and a plurality of pre-printed photograph descriptions 204 (Fig. 4; page 4, paragraph 0021, lines 3-5) for the blank photograph locations, each photograph description containing technical details of a photograph corresponding to the blank photograph location (page 4, paragraph 0021, lines 4-9).

Claim 10 is directed to a system 100 (Fig. 1; page 3, paragraph 0019, lines 1-2), comprising a camera 102 (Fig. 1; page 3, paragraph 0019, lines 2-3) and a guidebook 104 or 200 (Figs 1, 2; page 4, paragraph 0021, lines 1-3), the guidebook comprising a plurality of blank photograph locations 202 (Fig. 2; page 4, paragraph 0021, lines 2-4);

and a plurality of pre-printed photograph descriptions 204 (Fig. 4; page 4, paragraph 0021, lines 3-5) of the blank photograph locations.

Claim 20 is directed to a guidebook 104 or 200 (Figs 1, 2; page 4, paragraph 0021, lines 1-3) for taking photographs, comprising means for retrieving photograph details in a guidebook (for example, the plurality of blank photograph locations 202 (Fig. 2; page 4, paragraph 0021, lines 2-4) and descriptions 204 (Fig. 4; page 4, paragraph 0021, lines 3-5)); means for navigating to a photograph taking location (for example, camera with capability of determining location (paragraph 0019, page 3, line 3 through page 4, line 2) or a global positioning system (paragraph 0020, page 4, lines 6-9)); and means for orienting a camera according to the retrieved photograph details (for example, camera with capability of determining orientation and inclination (paragraph 0019, page 3, line 3 through page 4, line 2; or as in paragraph 0020, page 4, lines 3-9)).

Claim 23 is directed to a system 100 (Fig. 1; page 3, paragraph 0019, lines 1-2) for reproducing a base photograph (see also generally paragraph 0024, page 5), comprising a guidebook 104 or 200 (Figs 1, 2; page 4, paragraph 0021, lines 1-3) having a plurality of blank photograph locations 202 (Fig. 2; page 4, paragraph 0021, lines 2-4) and a plurality of pre-printed technical details (page 4, paragraph 0021, lines 4-9) for identifying each of the blank photograph locations; and means for replicating the technical details (for example, camera with capability of determining location (paragraph 0019, page 3, line 3 through page 4, line 2) or a global positioning system (paragraph 0020, page 4, lines 6-9); and orientation apparatus within the camera (for example, camera with capability of determining orientation and inclination (paragraph 0019, page 3, line 3 through page 4, line 2; or as in paragraph 0020, page 4, lines 3-9))).

VII. Grounds of Rejection to be Reviewed on Appeal

- Whether claims 20-21 are unpatentable under 35 U.S.C. § 112.
- Whether claims 1-9 and 20-21 are unpatentable under 35 U.S.C. § 103(a) over Ruebens (U.S. Pat. No. 4,965,948).

- Whether claims 10-13 and 23-24 are unpatentable under 35 U.S.C. § 103(a) over Sussman et al. (U.S. Pat. No. D468,350) or Smith (U.S. Pat. No. 6,257,621) in view of Ruebens.

VIII. Argument

A. Applicable Authorities

35 U.S.C. § 103

35 U.S.C. § 103(a) provides in relevant part:

Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

“The ultimate determination ... whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.” *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (1999) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)).

When applying 35 U.S.C. § 103, the claimed invention must be considered as a whole; the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention

and a reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) There must be a reasonable expectation of success; (3) The prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on appellants' disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See, e.g., In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Differences between the claims and the prior art are determined by new and unobvious functional relationship, as well as the relationship between the purpose of printed matter on a substrate and the substrate without the printed matter.

See In re Gulack, 217 USPQ 401:

A functional relationship of the precise type found by the CCPA in *Miller* — to size or to type of substrate, or conveying information about substrate — is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability.

The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. (*See In re Gulack*, 217 USPQ 401, emphasis in original).

See also See In re John Ngai and David Lin, 367 F.3d 1336, CAFC 2004:

In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. (*In re John Ngai and David Lin*, 367 F.3d 1336, CAFC 2004).

Definition of Claim Terms

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)).

B. Analysis**(i) Claim Rejections Under 35 U.S.C. § 112****(a) Claim 20**

Appellant made an amendment to claim 20 in its response dated July 2, 2007, to the Final Office Action mailed May 2, 2007. The Advisory Action indicated that the amendments of that response were entered. No indication of whether the rejection under 35 U.S.C. § 112 remains has been given. Appellant submits that the amendment overcame the rejection under 35 U.S.C. § 112 for claim 20.

(ii) Claim Rejections Under 35 U.S.C. § 103 over Ruebens**(a) General Remarks**

Appellant made specific arguments in its Response of November 3, 2006 to the original Office Action mailed August 17, 2006, that do not appear to have been considered. Final Office Action dated July 2, 2007, that do not appear to have been considered, as the Advisory Action never mentioned the arguments made except to make an unsupported statement that the "comments and/or amendments do not place the case in condition for allowance for the reasons set fourth (sic) in the final rejection." Appellant submits that there are arguments in the Response to Final Office Action that are neither contemplated nor addressed by the rejections of the Final Office Action.

Specifically, Appellant cited specific case law and provided arguments supporting its position, including case law and arguments that were never properly addressed. This case law, outlined above, includes *In re Gulack* and *In re John Ngai and David Lin*. Appellant submits that it is error not to have considered the specific arguments and case law presented in earlier prosecution. Appellant further submits that it is error to continue to reject the claims with rejections that do not even consider the Appellant's arguments in its response to Final Office Action.

The case law of *In re Gulack* and *In re John Ngai and David Lin* applies as set forth in Appellant's response to the Final Office Action.

(b) Claim 1

Claim 1 recites a specific arrangement and/or content of the printed matter, specifically the pre-printed photograph descriptions of the blank photograph locations. The Final Office Action admitted that Ruebens does not disclose the specific arrangement and/or content (See Final Office Action, page 3). The Final Office Action asserts, incorrectly and without support, that *In re Gulack* applies to the present claims. However, this is error.

In re Gulack, as interpreted by *In re John Ngai and David Lin*, clearly shows that claim 1 contains patentable subject matter not disclosed in Ruebens. The printed matter of the present claim is directed specifically to the purpose of the photo pages to achieving their purpose, that is, instructions and arrangement for obtaining photos as described on the photo pages. Without the printed matter, the photo pages could not achieve their purpose of holding specific photos identified and detailed in the printed matter, and without the photo pages, the instructions and the arrangement of the book could not achieve their purpose. In this manner, it is clear that there is a functional relationship between the printed matter and the substrate. The printed matter and the blank photograph locations of the present claims are interrelated, so as to produce a new product useful for educational and recreational mathematical purposes.

The rejection is in error under *In re Gulack* and *In re John Ngai and David Lin*, and it is error to maintain it.

(c) Claim 7

Claim 7 also recites a specific arrangement and/or content of the printed matter, specifically the pre-printed photograph descriptions of the blank photograph locations. The Final Office Action admitted that Ruebens does not disclose the specific arrangement and/or content (See Final Office Action, page 3). The Final Office Action asserts, incorrectly and without support, that *In re Gulack* applies to the present claims. However, this is error.

In re Gulack, as interpreted by *In re John Ngai and David Lin*, clearly shows that claim 7 contains patentable subject matter not disclosed in Ruebens. The printed matter

of the present claim is directed specifically to the purpose of the photo pages to achieving their purpose, that is, instructions and arrangement for obtaining photos as described on the photo pages. Without the printed matter, the photo pages could not achieve their purpose of holding specific photos identified and detailed in the printed matter, and without the photo pages, the instructions and the arrangement of the book could not achieve their purpose. In this manner, it is clear that there is a functional relationship between the printed matter and the substrate. The printed matter and the blank photograph locations of the present claims are interrelated, so as to produce a new product useful for educational and recreational mathematical purposes.

The rejection is in error under *In re Gulack* and *In re John Ngai and David Lin*, and it is error to maintain it.

(d) Claim 20

Claim 20 recites a specific arrangement and/or content of the printed matter, specifically the means for retrieving photograph details. The Final Office Action admitted that Ruebens does not disclose the specific arrangement and/or content (See Final Office Action, page 3). The Final Office Action asserts, incorrectly and without support, that *In re Gulack* applies to the present claims. However, this is error.

In re Gulack, as interpreted by *In re John Ngai and David Lin*, clearly shows that claim 20 contains patentable subject matter not disclosed in Ruebens. The means for retrieving photograph details of the present claim is directed specifically to the purpose of the photo pages to achieving their purpose, that is, instructions and arrangement for obtaining photos as described on the photo pages. Without the printed matter, the photo pages could not achieve their purpose of holding specific photos identified and detailed in the printed matter, and without the photo pages, the instructions and the arrangement of the book could not achieve their purpose. In this manner, it is clear that there is a functional relationship between the printed matter and the substrate. The printed matter and the blank photograph locations of the present claims are interrelated, so as to produce a new product useful for educational and recreational mathematical purposes.

The rejection is in error under *In re Gulack* and *In re John Ngai and David Lin*, and it is error to maintain it.

(iii) Claim Rejections Under 35 U.S.C. § 103 over Sussman et al. or Smith in view of Ruebens

(a) General Remarks

Appellant made specific arguments in its Response of November 3, 2006 to the original Office Action mailed August 17, 2006, that do not appear to have been considered. Final Office Action dated July 2, 2007, that do not appear to have been considered, as the Advisory Action never mentioned the arguments made except to make an unsupported statement that the “comments and/or amendments do not place the case in condition for allowance for the reasons set fourth (sic) in the final rejection.” Appellant submits that there are arguments in the Response to Final Office Action that are neither contemplated nor addressed by the rejections of the Final Office Action.

Specifically, Appellant cited specific case law and provided arguments supporting its position, including case law and arguments that were never properly addressed. This case law, outlined above, includes *In re Gulack* and *In re John Ngai and David Lin*. Appellant submits that it is error not to have considered the specific arguments and case law presented in earlier prosecution. Appellant further submits that it is error to continue to reject the claims with rejections that do not even consider the Appellant’s arguments in its response to Final Office Action.

The case law of *In re Gulack* and *In re John Ngai and David Lin* applies as set forth in Appellant’s response to the Final Office Action.

(b) Claim 10

Claim 10 recites a specific structure, namely a plurality of pre-printed photograph descriptions of the blank photograph locations. The Final Office Action admitted that Ruebens does not disclose the specific arrangement and/or content (See Final Office Action, page 5). The Final Office Action asserts, incorrectly and without support, that *In re Gulack* applies to the present claims. However, this is error.

In re Gulack, as interpreted by *In re John Ngai and David Lin*, clearly shows that claim 10 contains patentable subject matter not disclosed in Ruebens. The a plurality of

pre-printed photograph descriptions of the blank photograph locations of the present claim is directed specifically to the purpose of the photo pages to achieving their purpose, that is, instructions and arrangement for obtaining photos as described on the photo pages. Without the printed matter, the photo pages could not achieve their purpose of holding specific photos identified and detailed in the printed matter, and without the photo pages, the instructions and the arrangement of the book could not achieve their purpose. In this manner, it is clear that there is a functional relationship between the printed matter and the substrate. The printed matter and the blank photograph locations of the present claims are interrelated, so as to produce a new product useful for educational and recreational mathematical purposes.

The rejection is in error under *In re Gulack* and *In re John Ngai and David Lin*, and it is error to maintain it.

(c) Claim 23

Claim 23 recites a specific structure, namely a plurality of pre-printed technical details for identifying each of the blank photograph locations. The Final Office Action admitted that Ruebens does not disclose the specific arrangement and/or content (See Final Office Action, page 5). The Final Office Action asserts, incorrectly and without support, that *In re Gulack* applies to the present claims. However, this is error.

In re Gulack, as interpreted by *In re John Ngai and David Lin*, clearly shows that claim 23 contains patentable subject matter not disclosed in Ruebens. The a plurality of pre-printed photograph descriptions of the blank photograph locations of the present claim is directed specifically to the purpose of the photo pages to achieving their purpose, that is, instructions and arrangement for obtaining photos as described on the photo pages. Without the printed matter, the photo pages could not achieve their purpose of holding specific photos identified and detailed in the printed matter, and without the photo pages, the instructions and the arrangement of the book could not achieve their purpose. In this manner, it is clear that there is a functional relationship between the printed matter and the substrate. The printed matter and the blank photograph locations of the present claims are interrelated, so as to produce a new product useful for educational and recreational mathematical purposes.

The rejection is in error under *In re Gulack* and *In re John Ngai and David Lin*, and it is error to maintain it.

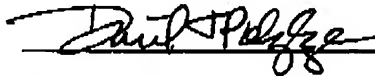
IX. Conclusion

Appellant has shown that the claims are distinguishable from the cited art by showing that the Office Actions admit a lack of elements of the claims, and rely instead on an incorrect and erroneous interpretation of *In re Gulack* and *In re John Ngai and David Lin*. As such, the rejections are in error.

For at least the reasons discussed above, Appellant submits that the pending claims are patentable. Accordingly, Appellant requests that the Board of Appeals reverse the Examiner's decisions regarding claims 1-13 and 20-24.

Respectfully submitted,

Date: 4 Dec. 2007



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APPENDIX A
Claims Appendix

1. A photography guidebook, comprising
a plurality of blank photograph locations; and
a plurality of pre-printed photograph descriptions of the blank photograph locations.
2. The photography guidebook of claim 1, wherein each of the plurality of descriptions comprises one or more of:
a camera location when the picture was taken;
coordinates for the object of the image of the photograph;
a magnetic bearing of the lens of the camera;
an inclination of the camera;
a shutter speed of the camera;
an aperture of the camera;
a plurality of environmental conditions; and
a film type for the camera.
3. The photography guidebook of claim 1, wherein the descriptions are placed in a portion of the guidebook separate from the photograph locations.
4. The photography guidebook of claim 1, wherein the descriptions are placed adjacent their respective photograph locations.
5. The photography guidebook of claim 1, wherein the descriptions comprises a caption for the photograph and a set of technical details of the photograph location.

6. The photography guidebook of claim 5, wherein the technical details are placed in a portion of the guidebook separate from the photograph locations and the captions.
7. An adventure workbook, comprising:
a plurality of blank photograph locations; and
a plurality of pre-printed photograph descriptions for the blank photograph locations, each photograph description containing technical details of a photograph corresponding to the blank photograph location.
8. The adventure workbook of claim 7, wherein the technical details comprise:
a camera location when the picture was taken;
coordinates for the object of the image of the photograph;
a magnetic bearing of the lens of the camera;
an inclination of the camera;
a shutter speed of the camera;
an aperture of the camera;
a plurality of environmental conditions; and
a film type for the camera.
9. The adventure workbook of claim 7, wherein the technical details are placed in a portion of the guidebook separate from the photograph locations and the captions.
10. A system, comprising:
a camera; and
a guidebook, the guidebook comprising:
a plurality of blank photograph locations; and
a plurality of pre-printed photograph descriptions of the blank photograph locations.

11. The system of claim 10, wherein each of the plurality of descriptions comprises one or more of:
 - a camera location when the picture was taken;
 - coordinates for the object of the image of the photograph;
 - a magnetic bearing of the lens of the camera;
 - an inclination of the camera;
 - a shutter speed of the camera;
 - an aperture of the camera;
 - a plurality of environmental conditions; and
 - a film type for the camera.
12. The system of claim 10, wherein the descriptions are placed in a portion of the guidebook separate from the photograph locations.
13. The system of claim 10, wherein the descriptions are placed adjacent their respective photograph locations.
20. A guidebook for taking photographs, comprising:
 - means for retrieving photograph details in a guidebook;
 - means for navigating to a photograph taking location; and
 - means for orienting a camera according to the retrieved photograph details.
21. The guidebook of claim 20, wherein the photograph details comprise at least one of a camera location when the picture was taken, coordinates for the object of the image of the photograph, a magnetic bearing of the lens of the camera, an inclination of the camera, a shutter speed of the camera, an aperture of the camera, a plurality of environmental conditions, and a film type for the camera.
23. A system for reproducing a base photograph, comprising:

a guidebook having a plurality of blank photograph locations and a plurality of pre-printed technical details for identifying each of the blank photograph locations;
and
means for replicating the technical details.

24. The system of claim 23, wherein the means for replicating comprises:
a camera; and
wherein each of the plurality of technical details comprises one or more of:
a camera location when the picture was taken;
coordinates for the object of the image of the photograph;
a magnetic bearing of the lens of the camera;
an inclination of the camera;
a shutter speed of the camera;
an aperture of the camera;
a plurality of environmental conditions; and
a film type for the camera.

APPENDIX B**Evidence Appendix**

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

APPENDIX C**Related Proceedings Appendix**

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.